

REMARKS

The Office Action dated August 14, 2003 has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing claims are tendered with the conviction that patentable contrast has been made manifest over the known prior art and certain typographical inexactitudes have been rectified to provide better form. All rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

It is believed that the foregoing revisions to the claims are within the metes and bounds of the recently articulated Supreme Court *Festo* case, in that all equivalents susceptible to capture have been retained in that one skilled in the art, at the time of this amendment, could not have reasonably be expected to have drafted a claim that would have literally encompassed any other equivalent.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1 through 36 under 35 U.S.C. § 103 as being unpatentable over Spencer (6,356,909) in view of Sheflott et al. (5,802,493).

Spencer discloses a system for generating request for proposal forms, responses to such forms, and analysis, reporting and storage of the results (col. 6, lines 1-4).

Sheflott et al. discloses a system for generating answers to a request for proposal, composed of questions, using a database of similar questions (col. 3, lines 45-56). The invention is tailored to proposals made by insurance companies (col. 5,

lines 19-20). The process is designed to streamline the process of completing such questionnaires by eliminating the various steps generally taken in the prior art (e.g., col. 6, lines 14-52).

At the outset, the Examiner has mischaracterized the cited references, which have absolutely nothing to do with the instant invention as claimed. Further, the Examiner makes no attempt to correlate the claimed elements of the present invention with any elements disclosed in Spencer or Sheflott et al. For example, a cursory examination of Spencer and Sheflott et al. reveals no discussion of how bids are handled, which is a focal point of the instant invention. Spencer and Sheflott concern themselves exclusively with preparing, answering, and analyzing answers in questionnaires.

The Examiner is in error in suggesting combining Spencer and Sheflott et al. on the apparent belief that all requests for proposals and requests for quotations are interchangeable. Spencer and Sheflott are specifically applicable to "requests for proposals" that are in a questionnaire format (see, e.g., Spencer, col. 1, lines 55-60; Sheflott et al., col. 5, lines 20-23). Sheflott et al. specifically mentions that bids are considered later in the process than the questionnaire portion of the process to which it pertains (col. 5, line 61 through col. 6, line 3).

In contrast, the present invention provides a means for providing a bid package to sellers in a manner that is advantageous to both buyers and sellers. The packages are sequestered into modules (see, e.g., claim 1) that may be individually bid upon by sellers. Where in the prior art are there modules? Thus, a seller who deals exclusively in a particular good or service is provided a business opportunity

that it might not have if the package were not so sequestered. The modular process widens the potential marketplace in terms of the goods and services that are procured, in addition to providing access to a global marketplace through the Internet. The present invention as claimed has nothing to do with the preparation of questionnaires or the use of a question and answer database in response to questionnaires.

It is Black Letter Law the Patent and Trademark Office's burden is to establish a prima facie case of obviousness. The Patent and Trademark Office has met its burden only when it fully describes: "1) What the reference discloses, teaches and suggests to one skilled in the art; 2) What the reference lacks in disclosing, teaching or suggesting vis-à-vis the claimed features; 3) What particular teaching or suggestion is being relied upon either via a reference itself or knowledge of person of ordinary skill in the art; 4) A statement explaining the proposed modification in order to establish the prima facie case of obviousness; and finally 5) the motivation behind the statement of obviousness which comes from three sources: a) teachings of the prior art; b) nature of the problem to be solved; or c) knowledge of persons of ordinary skill in the art", see *In re Rouffet* 47 USPQ2d 1453 (Fed. Cir. 1998).

In the absence of such a prima facie showing, the Examiner's rejection cannot stand:

"Decision rejecting claims in utility application as obvious over combination of prior art references *must be reversed*, since obviousness analysis in decision is limited to discussion of ways that multiple references can be combined to read on claimed invention, but *does not particularly identify any suggestion, teaching, or motivation to combine references, and does not include specific or inferential findings concerning identification of relevant art, level of ordinary*

skill in art, nature of problem to be solved, or any other factual findings that might support proper obviousness analysis." In re Dembiczak, 50 U.S.P.Q.2d 1614. [Emphasis added.]

The Examiner has not made a prima facie of obviousness, having failed to identify where any elements of the claimed invention are present in the cited references or combination of references and what possible motivation could exist for combining two such references having no connection to the present invention. The mere fact that Spencer and Sheflott et al. refer to a concept called "a request for proposal" does not mean that the inventions thus disclosed are remotely applicable to the instant case. They are not remotely applicable. The rejection under 35 U.S.C. § 103 must, therefore, be withdrawn.

Applicant, in order to make crystal clear the concept of modules, has particularized them for sharper patent contrast.

Rejections under 35 U.S.C. § 112

The Examiner has rejected claims 1 through 36 under 35 U.S.C. § 112, second paragraph, for failing to point out and particularly claim what applicant regards is the invention.

At page 3 of the Office Action, the Examiner opines "Then [sic] independent claims are too broad to specifically claim a piece of material which is distinguishable over the art." The Examiner offers no support of which language is too broad, or which concepts are present in the prior art. It is noted hereinabove that the Examiner has particularly failed to produce a single, relevant prior art reference or combination of references that contains all (or even any) of the elements of the

instant invention as claimed. breadth of the patent claims is clearly warranted in the absence of prior art.

Undersigned refers to claim 1 by way of example. The Examiner has not produced a reference that sequesters a bid package into modules. This step is specific as to its requirements, and the Examiner has found no such element. Releasing modules for bids and combining the received bids is likewise specific and clear. The Examiner is respectfully requested to particularize which portions of the claims are found (or not found) in the prior art. Doubtless, if such concepts are as broad and widespread as the Examiner suggests, such concepts must be present somewhere in a printed publication, which meets the required standard for rejection.

The rejection under 35 U.S.C. § 112 is thus inapplicable to the claims of the present invention, which clearly point out and particularly claim the elements of the instant invention. Nonetheless, as an accommodation, undersigned points to the module particularization to assuage the Examiner's apprehension.

The Examiner is respectfully requested to note that the Office Action to which this amendment responds was mailed on August 14, 2003, thereby requiring a response on February 14, 2004. February 14, 2004 was a Saturday. Monday, February 16, 2004, was a Federal holiday in the District of Columbia. Therefore, this amendment is timely filed on Tuesday, February 17, 2004.

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve

same. Undersigned has enclosed a Request for Personal Interview to assist in expediting issuance of the present case.

Dated: February 17, 2004

Respectfully Submitted:



BERNHARD KRETEN
Applicant's Attorney
Telephone (916) 930-9700
Registration No.: 27,037